



PATENT

Attorney Docket No. 05569.0004.DVUS12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

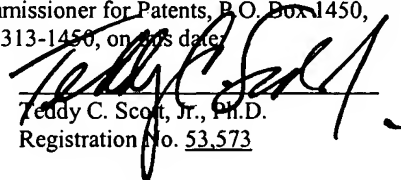
Applicant(s): McCafferty, et al.  
App. No.: 10/803,653  
Confirmation No.: 8022  
Filing Date: March 18, 2004  
Title: Methods for Producing Members of  
Specific Binding Pairs  
Art Unit: 1645  
Examiner: To Be Assigned

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date:

07/09/04

Date

  
Teddy C. Scott, Jr., Ph.D.  
Registration No. 53,573

REQUEST FOR CORRECTION TO FILING RECEIPT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sirs:

In response to the Notice Regarding Benefit/Priority Claim mailed April 26, 2004, we are enclosing herewith a copy of the Official Filing Receipt received from the U.S. Patent & Trademark Office with a correction priority claim marked in red ink.

The Notice Regarding Benefit/Priority Claim indicated that Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated the prior-filed application is a national application under 37 U.S.C. 371, and requests applicant to provide evidence that the prior-filed application is a national stage application.

This application is a divisional application of U.S. Patent Application No. 09/726,219, filed November 28, 2000, which is a continuation of U.S. Patent Application No. 08/484,893, filed June 7, 1995 (now U.S. Patent No. 6,172,197), which is a continuation of U.S. Application No. 07/971,857 (the "857 Application"), which is the National Stage of PCT/GB91/01134, filed July 10, 1991 (now U.S. Patent No. 5,969,108). Enclosed herewith is a copy of the first page of U.S. Patent No. 5,969,108, which indicates that the '857 Application was a national stage application filed under 35 U.S.C. 371. Applicants also submit herewith a Preliminary Amendment Under 37 C.F.R. § 115 clarifying the priority claim.

U.S. Application No. 10/803,653  
Filed: March 18, 2004

Docket No. 05569.0004.DVUS12

Please ensure that this correction is entered, and that a Corrected Filing Receipt is mailed to our office.

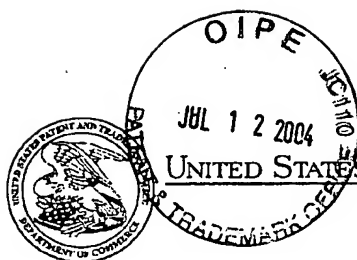
Respectfully submitted,

HOWREY SIMON ARNOLD & WHITE, LLP

By: 

Teddy C. Scott, Jr., Ph.D.  
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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/803,653	03/18/2004	1645	770	05569.0004.DVUS12	46	5	1

CONFIRMATION NO. 8022

HOWREY SIMON ARNOLD & WHITE, LLP  
Attention: Box No. 34  
1299 Pennsylvania Avenue, N.W.  
Washington, DC 20004-2402

## FILING RECEIPT



\*OC000000012453741\*

Date Mailed: 04/26/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

John McCafferty, Sawston, UNITED KINGDOM;  
Anthony Richard Pope, Cambridge, UNITED KINGDOM;  
Kevin Stuart Johnson, Cambridge, UNITED KINGDOM;  
Henricus Renerus Jacobus Mattheus Hoogenboom, Cambridge, UNITED KINGDOM;  
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Gregory Paul Winter, Cambridge, UNITED KINGDOM;  
Timothy Peter Bonneri, Cambridge, UNITED KINGDOM;

## Assignment For Published Patent Application

Cambridge Antibody Technology Limited;  
Medical Research Council;

## Domestic Priority data as claimed by applicant

This application is a DIV of 09/726,219 11/28/2000  
which is a CON of 08/484,893 06/07/1995 PAT 6,172,197  
which is a CON of 07/971,857 01/08/1993 PAT 5,969,108

Which is a 371 of PCT/GB91/01134 filed

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HOWREY SIMON ARNOLD & WHITE

APR 28 2004

July 10, 1991

## Foreign Applications

UNITED KINGDOM PCT/GB92/00883 07/19/1991  
UNITED KINGDOM 9015198.6 07/10/1990

WASHINGTON, D.C.

UNITED KINGDOM 9022845.3 10/19/1990  
UNITED KINGDOM 9024503.6 11/12/1990  
UNITED KINGDOM 9104744.9 03/06/1991  
UNITED KINGDOM 9110549.4 05/15/1991

**If Required, Foreign Filing License Granted:** 04/23/2004

**Projected Publication Date:** 08/05/2004

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Methods for producing members of specific binding pairs

**Preliminary Class**

435

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**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/803,653	03/18/2004	John McCafferty	05569.0004.DVUS12

HOWREY SIMON ARNOLD & WHITE, LLP  
 Attention: Box No. 34  
 1299 Pennsylvania Avenue, N.W.  
 Washington, DC 20004-2402

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 HOWREY SIMON ARNOLD & WHITE

APR 28 2004

Date Mailed: 04/26/2004

CONFIRMATION NO. 8022



\*OC000000012452524\*

WASHINGTON, D.C.

## Notice Regarding Benefit/Priority Claim(s)

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed nonprovisional application(s) is improper because there is no specific reference for each prior-filed application that includes: (1) the identification of the prior-filed application by application number, or international application number and international filing date; and (2) a clear indication the relationship (i.e., continuation, divisional, or continuation-in-part) of the nonprovisional applications. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed application(s) as required by 37 CFR 1.78. A proper relationship includes an identification of each nonprovisional application as a continuation, divisional or continuation-in-part application of the immediate prior-filed nonprovisional application for which a benefit is claimed under 37 CFR 1.78 in order to establish copendency throughout the entire chain of prior-filed applications. The specific reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed. See 37 CFR 1.78(a).

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed provisional application(s) is improper because the instant application was not filed within twelve (12) months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the

benefit of the provisional application and filed within 12 months of the filing date of the provisional application. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,--- filed---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed applications (including an indication of any intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed with 12 months of the filing date of the provisional application) as required by 37 CFR 1.78. The required reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed during the pendency of the instant application.

☐ **Improper Priority Claim(s) to Prior-Filed Foreign Application(s)**

The instant application was not filed within twelve (12) months from the filing date of the prior-filed foreign application, and there is no benefit claim to an intermediate nonprovisional application filed within 12 months of the filing date of the foreign application. Applicant should review each priority claim submitted and, if appropriate, provide the proper reference to any intermediate nonprovisional application filed within 12 months of the filing date of the foreign application in compliance with 37 CFR 1.78, or delete the priority claim. The required reference to an intermediate nonprovisional application must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for the benefit claim to an intermediate nonprovisional application must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed.

☐ **Benefit Claims to More Than 400 Prior-Filed Applications**

The Office's automated system to record and capture benefit claims is only capable of recording benefit claims for 400 prior-filed applications. Therefore, the Office is unable to generate a filing receipt containing benefit claims for more than 400 prior-filed applications even though applicant is entitled to submit benefit claims for more than 400 prior-filed applications. Accordingly, applicant should not request a corrected filing receipt to include benefit claims for more than 400 prior-filed applications.

☒ **Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35 U.S.C. 371) Application**

Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior-filed application is a national stage application under 35 U.S.C. 371. The Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a). The Office has entered the benefit claim to the prior-filed application as a benefit claim to an application filed under 35 U.S.C. 111(a). Any request for a corrected filing receipt to include the indication that the prior-filed application is a national stage application will not be granted unless applicant supplies evidence that the prior application was in fact a national stage application. Accordingly, applicant should not submit such request without such evidence. Applicant should submit an amendment (or an application data sheet (ADS) if the benefit claim was submitted in an ADS) to delete the indication that the prior-filed application is a national stage application.

For more information and examples on benefit claims, please see Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c), 1268 Off. Gaz. Pat. Office 89 (March 18, 2003), which is available on the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>, and the Manual of Patent Examining Procedure (MPEP) §§ 201.11 and 201.14.

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